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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,226	10/20/2003	Edward Goldberg	287/12	4068

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EXAMINER

BRITTAIN, JAMES R

ART UNIT PAPER NUMBER

3677

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/689,226	GOLDBERG, EDWARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	James R. Brittain	3677	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-14,26 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) 12,26,29 and 30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 35 is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,13,14 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on May 5, 2005 is acknowledged.

Claims 12, 26, 29 and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 5, 2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-9 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The passage "said by being firmly secured to said body so as to extend rearwardly behind said head portion" (claim 1, lines 13-14) appears to be incomplete at the very beginning of the limitation "said by" and is of unknown scope. The remaining claims are indefinite because they depend from an indefinite claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelleghan (US D486377) in view of Henderson et al. (US 6247730) and Ayon et al. (US 4815999).

Further, Kelleghan (figures 1-5) teaches a novelty figurine comprising a head portion, a body portion and a carabiner attachment assembly extending from the body portion for selectively allowing the figurine to be attached to or removed from another item able to receive the carabiner, the attachment assembly comprising three equally curved contiguous legs with one of the legs having a selectively openable gate. Figures 4 and 5 clearly show that the fish is of a wider dimension than the carabiner so as to hide it when viewed from the front as shown in figure 4.

The difference is that Kelleghan fails to place a door in the figurine for storing items therein.

However, Henderson et al. (figures 1, 2) teaches forming a facial body 12 with a mouth 16 that can be opened and closed to store an item therein while using a snap hook 20 to secure the facial body to an item. Further, Ayon (figures 1, 2) teaches that it is common when utilizing a figurine with a 3-dimensional face 38 to utilize a handle 62 to hold the figurine while also having a door 50 hinged 54 so that items can be placed in the body of the figurine.

As it would be beneficial to utilize the device Kelleghan for added utility so as to store items, it would have been obvious to modify the device of Kelleghan so as to place a door in the figurine for storing items therein in view of Henderson et al. (figures 1, 2) teaching forming a facial body 12 with a mouth 16 that can be opened and closed to store an item therein while using a snap hook 20 to secure the facial body to an item and Ayon (figures 1, 2) teaching that it

is common when utilizing a figurine with a 3-dimensional face 38 to utilize a handle 62 to hold the figurine while also having a door 50 hinged 54 so that items can be placed in the body of the figurine a benefit with utility over the design of the figurine of Kelleghan.

Claims 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelleghan (US D486377) in view of Henderson et al. (US 6247730) and Ayon et al. (US 4815999) as applied to claim 1 above, and further in view of JP 10-118340.

Further modification of the figurine of Kelleghan so that the figurine is an item that can stand would have been obvious since standing figurines or dolls are well known as evidenced by JP 10-118340 (figure 1a, 2) that shows a standing doll with a hinged door for storage. As to claims 5, 6, 11, 19, 20 and 25, JP 10-118340 suggest in figures 4, 5, 10, 11 hinging the door in the lower portion of the body with a securement feature at the top of the door so as to have the storage compartment within the body of the of the figurine when the door is closed. It would have been obvious to further modify the figurine of Kelleghan so that the door suggested by Ayon et al. is in the body of the figurine so as to have easier access. As to claims 7-9, the placement of the head at the top of the door is an aesthetic choice over the stopping of the door in below the head of the doll as taught by JP 10-118340 and as an aesthetic choice it lacks any utility and is obvious over the teachings of JP 10-118340.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelleghan (US D486377) in view of Henderson et al. (US 6247730) and Ayon et al. (US 4815999) as applied to claim 1 above, and further in view of Forrest (US 3563430).

Further modification of Kelleghan, which doesn't clearly show the construction of the carabiner so as to utilize either a pivoted gate or resilient gate for the construction of the

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carabiner gate would have been obvious in view of Forrest (figures 2, 4) teaching that both configurations provide adequate functioning gates to hold on the carabiner.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-78874 in view of Abbondandolo (US 6554680).

JP 2001-78874 (figure 3) teaches a novelty figurine comprising a head portion, a body portion including a neck portion located proximate the head portion and a carabiner attachment assembly 1 extending from the neck portion via the tether 2, 3, 6, 7 for selectively allowing the figurine to be attached to or removed from another item able to receive the carabiner, the attachment assembly comprising three legs with one of the legs having a selectively openable gate. The difference is that the attachment is not clearly to the body portion. It would have been obvious to move the attachment to the body portion in view of Abbondandolo (figure 1) in which the attachment 13, 15 portion is clearly mounted in the body so as to lower the location of attachment. As to claim 33, applicant seeks to differentiate a body portion from a leg portion. However, there is no difference in the utility of the support structure from that taught by either JP 2001-78874 or Abbondandolo and is obvious thereover.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-78874 in view of Abbondandolo (US 6554680) as applied to claim 32 above, and further in view of Millard (US 1566801).

Further modification of the novelty figure of JP2001-78874 such that the head is releasable would have been obvious in view of Millard (figures 1, 4, 5) which teaches making the head selectively releasable so as to vary the head so as to make it a more interesting toy for a child.

***Allowable Subject Matter***

Claims 10 and 35 are allowed.

***Response to Arguments***

Applicant's arguments filed May 8, 2006 have been fully considered but they are not persuasive.

Applicant argues that Kelleghan fails to show the carabiner hidden from view when the figurine is viewed from the front. However, the figurine of Kelleghan can be viewed as shown in figure 4 wherein the carabiner is hidden from view, and therefore meets the limitation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant alleges that since the primary references constitute novelty items

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without storage, there is no need to look at any other teachings. There is no basis to ignore the teachings of the secondary references. The body of art, exemplified by the secondary references, show novelty items wherein it is desirable to store items within them. The combined teachings of the primary and secondary references show that it is desirable to suspend novelty items with hooks and to store objects within novelty items. The combined teachings of the primary and secondary references render obvious the subject matter of these claims.

As to claim 32, applicant apparently considers a standing dolls or figurines to be non-obvious. Standing dolls or figurines are ubiquitous in this art, are common in bobble heads and the applied Japanese reference shows a standing figurine so applicant's argument is unpersuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



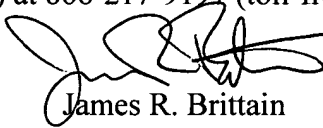
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065.

The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain  
Primary Examiner  
Art Unit 3677

JRB